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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,430	08/08/2001	Tilo Christ	265/256	9943
28204	7590	03/03/2006	EXAMINER	
SIEMENS SCHWEIZ I-44, INTELLECTUAL PROPERTY ALBISRIEDERSTRASSE 245 ZURICH, CH-8047 SWITZERLAND			GLASS, RUSSELL S	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/923,430		CHRIST ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Russell S. Glass		3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 2- 7, 9-12, 17- 19, 20, 22, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the sending step recited in line 2 of claim 4 that is to proceed the steps recited in claims 4 and 5.
3. Claims 17, 19, and 26 use the word "quality". The term "quality" in claim s 17, 19 and 26 is a relative term which renders the claims indefinite. The term "quality" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.
4. In claim 17, the criterion is described as a "quality" of the first medical data record. In claim 19, the service provided is described as a "quality" of the first medical assessment. Examiner is unclear as to what a "quality" is in this context.
5. In claim 26, a means for checking the "quality" is disclosed. The term quality is indefinite in this context because it is unclear what is to be considered in checking the "quality".

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6. Claims 2, 3, 6, 7, 9-12, 18, 19, 22 recites the limitation "the ascertained institution". There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 6-19, 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Pinsky et al., (U.S. 5,655,084).

8. As per claim 1, Pinsky discloses a computerized method for ascertaining a suitable institution making a first medical assessment on the basis of a first medical data record of a first patient, comprising the steps of:

(a) receiving at a central location a first order for the first medical assessment to be made for the first patient from a first location, (Pinsky, col. 2, lines 10-12), and

(b) ascertaining from a set of institutions, on the basis of the first order, the suitable institution for making the first medical assessment on the basis of the first order, (Pinsky, col. 2, lines 13-17).

9. As per claim 2, Pinsky discloses the method as claimed in claim 1, further comprising the steps of sending the identity of the ascertained institution from the central location to the first location, wherein the first medical data record of the first

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patient may be sent to the ascertained institution for the purpose of making the first medical assessment, (Pinsky, col. 2, lines 17-17; col. 4, lines 30-37).

10. As per claim 3, Pinsky discloses the method as claimed in claim 1, wherein the first order comprises the first medical data record of the first patient, further comprising the step of forwarding the first medical data record from the central location to the ascertained institution for the purpose of making the first medical assessment, (Pinsky, col. 2, lines 17-19).

11. As per claim 6, Pinsky discloses the method as claimed in claim 1, further comprising the step of the ascertained institution sending the first medical assessment made to the first location, (Pinsky, col. 6, lines 39-47).

12. As per claim 7, Pinsky discloses the method as claimed in claim 1, further comprising the steps of the ascertained institution sending the first medical assessment made to the central location, and the first medical assessment made being forwarded from the central location to the first location, (Pinsky, col. 4, lines 49-58).

13. The method as claimed in claim 1, wherein the institution is a doctor, a team of doctors and/or a hospital, (Pinsky, col. 4, lines 11-19)(a regional radiology hub or strategic radiology partner is equivalent to a doctor, team of doctors, and/or a hospital).

14. As per claim 9, Pinsky discloses the method as claimed in claim 2, wherein the first medical data record has an associated image, video film, laboratory results for the patient, ECG and/or patient file for the first patient, (Pinsky, col. 9, lines 29-47).

15. As per claim 10, Pinsky discloses the method as claimed in claim 3, wherein the first medical data record has an associated image, video film, laboratory results for the

patient, ECG and/or patient file for the first patient, (Pinsky, col. 9, lines 29-47).

16. As per claim 11, Pinsky discloses the method as claimed in claim 10, wherein the associated image has been taken using a medical imaging apparatus, (Pinsky, col. 9, lines 29-61).

17. As per claim 12, Pinsky discloses the method as claimed in claim 11, in which the medical imaging appliance is a computer tomograph, a magnetic resonance apparatus, an ultrasound apparatus or an X-ray apparatus, (Pinsky, col. 9, lines 29-61).

18. As per claim 13, Pinsky discloses the method as claimed in claim 1, wherein the first order is sent over a data network, (Pinsky, col. 5, lines 40-50; col. 7, lines 35-45).

19. As per claim 14, Pinsky discloses the method as claimed in claim 1, wherein the first medical data record and/or the first medical assessment are sent over a data network, (Pinsky, col. 5, lines 40-50; col. 7, lines 35-45).

20. As per claim 15, Pinsky disclose the method as claimed in claim 1, wherein the suitable institution is ascertained at the central location on the basis of at least one criterion, (Pinsky, col. 3, lines 45-56).

21. As per claim 16, Pinsky discloses the method as claimed in claim 15, in which the criterion is a demanded quality for the first medical assessment made, a medical specialization of the institution, a period of time for making the first medical assessment, a number of medical assessments which the institution can make in a prescribed period of time, the fee demanded by the institution for making the first medical assessment, and/or legal regulations, (Pinsky, col. 3, lines 45-56).

22. As per claim 17, Pinsky discloses the method as claimed in claim 15, in which

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the criterion is a quality of the first medical data record received at the central location from the first location, (Pinsky, col. 3, lines 45-56).

23. As per claim 18, Pinsky discloses the method as claimed in claim 1, further comprising the step of monitoring at the central location a service provided by the ascertained institution, (Pinsky, col. 3, lines 39-44).

24. As per claim 19, Pinsky discloses the method as claimed in claim 18, in which the service provided is a quality of the first medical assessment made, adherence to a prescribed period of time for making the first medical assessment, and/or adherence to the making of a prescribed number of medical assessments, (Pinsky, col. 3, lines 39-44).

25. As per claim 23, Pinsky discloses a system for ascertaining a suitable institution for making a medical assessment on the basis of a medical data record of a patient, comprising a database which is arranged at a central location configured to be contacted by an orderer over a data network in order to ascertain the suitable institution, so that the orderer is able to send to the database an order comprising the medical data record for the purpose of ascertaining the suitable institution, means for storing data from a set of institutions, and means for comparing the order with the data which are stored in the means for storing data from a set of institutions, (Pinsky, Figs. 2A-2C; col. 3, line 57-col. 4, line 58).

26. As per claim 24, Pinsky discloses the system as claimed in claim 23, further comprising forwarding means configured to forward the medical data record to the ascertained institution, (Pinsky, col. 3, lines 45-37).

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27. As per claim 26, Pinsky discloses the system as claimed in claim 23, further comprising means for checking the quality of the medical assessment made by the institution, (Pinsky, col. 3, lines 39-56).

28. As per claim 27, Pinsky discloses a system, comprising a database operatively coupled to a central processor, wherein the system is configured to:

- (a) store data for a set of institutions, (Pinsky, col. 4, lines 2-7),
- (b) receive from a first location a first order for a first medical assessment to be made for a first patient, wherein the first order comprises a first medical data record of the first patient, (Pinsky, col. 3, line 66-col 4, line 7),
- (c) compare the first order with the stored data for the set of institutions, (Pinsky, col. 4, lines 8-29),
- (d) select an institution from the set of institutions based on the comparison, wherein the selected institution is suitable for making a medical assessment of the first patient, (Pinsky, col. 4, lines 8-29), and
- (e) forward the first medical data record to the selected institution, (Pinsky, col. 4, lines 30-37).

29. As per claim 28, Pinsky discloses a computerized method, comprising the steps of:

- (a) receiving at a central location from a first location a first order for a first medical assessment to be made for a first patient, wherein the first order comprises a first medical data record of the first patient, (Pinsky, col. 3, line 66-col 4, line 7),



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- (b) based on the first order and the first medical data record, selecting at the central location an institution from a set of institutions, wherein the selected institution is suitable for making a medical assessment of the first patient, (Pinsky, col. 4, lines 8-29), and
- (c) forwarding the first medical data record from the central location to the suitable institution, (Pinsky, col. 4, lines 30-37).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 4, 5, 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinsky.

31. As per claim 4, Pinsky suggests the method as claimed in claim 1, further comprising, after the sending step, the step of entering the first order in a list, the list comprising orders for which no suitable institution has yet been ascertained in each case, and the list being able to be inspected by institutions from the set of institutions in order to send an offer for making the medical assessment to the central location.

Pinsky discloses a method wherein the administrative site sends an offer to an interpretation site to make a medical assessment. A backlog list is formed that represents offers that have not been acted upon. If the backlog list is too long, then the offer is sent to another interpretation site. The claimed method is simply the reverse in

that the offer to make the medical assessment is sent from the institution (institution is considered equivalent to interpretation site) to the central location (central location is equivalent to administrative site), by viewing the list (list is equivalent to backlog) and finding a medical record to assess.

It would be obvious to one of ordinary skill in the art to reverse the method disclosed by Pinsky. The motivaton would be to make high quality radiology interpretation services available to all areas uniformly and on an as-needed basis, (Pinsky, col. 2, lines 44-47).

32. As per claim 5, Pinsky discloses the method as claimed in claim 4, in which the list can be retrieved over the Internet, (Pinsky, col 5, lines 40-50; col. 7, lines 35-45).

It would be obvious to one of ordinary skill in the art to reverse the method disclosed by Pinsky. The motivaton would be to make high quality radiology interpretation services available to all areas uniformly and on an as-needed basis, (Pinsky, col. 2, lines 44-47).

33. As per claim 21, Pinsky suggests the method as claimed in claim 1, wherein the first order received at the central location from the first location is an order for making a plurality of medical assessments for a plurality of patients, wherein the first order comprises medical data records required for making medical assessments, and wherein the medical assessments are made by one institution or by a plurality of institutions from the set of institutions, (Pinsky, col. 3, line 57-col. 4, line 58).

Pinsky fails to disclose a method of making medical assessments for a plurality of patients. However the method in Pinsky can be repeated simultaneously on a large number of patients.

It would be obvious to one of ordinary skill in the art to conduct the method in Pinsky on a plurality of patients. The motivation would be to increase profits by simply increasing the number of patients serviced.

34. The method as claimed in claim 3, further comprising the steps of receiving at the central location a second order for making a second medical assessment of a second patient from a second location, the second order comprising a second medical data record of the second patient, which second medical data record is required for making the second medical assessment, the central location placing the first and second orders with an institution from the set of institutions as a collective order for making the first and second medical assessments, and sending the first and second medical data records from the central location to the institution, (Pinsky, col. 3, line 57-col. 4, line 58).

Pinsky fails to disclose a method of making medical assessments for a second patient. However the method in Pinsky can be repeated simultaneously on a number of patients.

It would be obvious to one of ordinary skill in the art to conduct the method in Pinsky on a second patient. The motivation would be to increase profits by simply increasing the number of patients serviced.

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Claim 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinsky in view of Lavin et al., (U.S. 5,772,585).

35. As per claim 20, Pinsky discloses the method as claimed in claim 1. However, Pinsky fails to disclose a method further comprising the steps of generating an invoice for the first medical assessment made at the central location and sending the invoice to the first location.

Invoicing is well known in the art as evidenced by Lavin. Lavin discloses a system and method for managing medical records comprising the steps of generating an invoice for the first medical assessment made at the central location and sending the invoice to the first location, (Lavin, col. 13, lines 9-59) (Billing is equivalent to invoicing).

It would be obvious to one of ordinary skill in the art to include the invoicing function of Lavin into system and method disclosed by Pinsky. The motivation would be to create a comprehensive system and method that would include invoicing.

36. As per claim 25, Pinsky discloses the system as claimed in claim 23. However, Pinsky fails to disclose a system further comprising means for producing an invoice wherein the invoice producing means is configured to produce an invoice for ascertaining the suitable institution and send the invoice to the orderer.

Invoicing is well known in the art as evidenced by Lavin. Lavin discloses a system and method for managing medical records comprising means for producing an invoice wherein the invoice producing means is configured to produce an invoice for ascertaining the suitable institution and send the invoice to the orderer., (Lavin, col. 13, lines 9-59) (Billing is equivalent to invoicing).

It would be obvious to one of ordinary skill in the art to include the invoicing function of Lavin into system and method disclosed by Pinsky. The motivation would be to create a comprehensive system and method that would include invoicing.

### ***Conclusion***

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: Westfall, (U.S. Pub. 2003/0208382; Soll et al., (U.S. Pub. 2003/0055679; Killcommons et al., (U.S. Pub. 2002/0184325); Joao, (U.S. Pub. 2001/0032099); Evans, (U.S. 5,924,074); Ballantyne et al., (U.S. 5,867,821); Cummings, Jr., (U.S. 5,301,105); Besette, (U.S. 6,263,330); Tallman et al., (U.S. 5,471,382); Kneebush, (U.S. Pub. 2002/0178055); Chishti et al., (U.S. Pub. 2002/0133386); Saito et al., (U.S. Pub. 2002/0026329); Costello, (U.S. pub. 2002/0022972); McCartney, (U.S. 5,778,345).

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

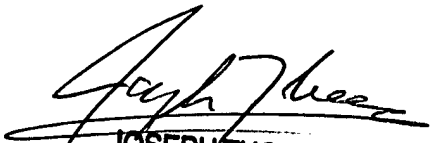
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RSG

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JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER